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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/815,394 | 04/01/2004 | Marcus Braun | 04265352 | 7591 |

7590 10/05/2006

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EXAMINER

TOY, ALEX B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3739

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,394

Applicant(s)

BRAUN, MARCUS

Examiner

Alex B. Toy

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 3-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/20/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 5-7 and 9-14 are objected to because of the following informalities: In claims 5 and 9, "the handle member" should be replaced by – the instrument handle – to maintain proper antecedent basis. Appropriate correction is required.

Claims 12 and 13 are objected to because of the following informalities: Claim 12 should depend from claim 5 and not claim 4. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3, 4, 8, 12, and 14 recite "especially" or "preferably". This language renders the claims indefinite because it is not clear whether the claims are positively limited by the language that follows "especially" or "preferably". Therefore, the metes and bounds of the claims are not clearly set forth as required.

Appropriate correction is required.

Allowable Subject Matter

Claims 1 and 2 are allowed.

Claims 3-14 would be allowable upon correction of the preceding claim objections and 35 U.S.C. 112, second paragraph rejections.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding independent claim 1, it is known in the prior art to have a surgical instrument with an effector that is rotatably and pivotably supported at one end. Klieman (U.S. Pat. No. 5,827,323) discloses such a surgical instrument, further wherein a gear train is provided for effecting a pivoting movement of the effector. Although Klieman does not disclose a gear train for effecting the rotational movement of the effector, it is known and obvious to use a gear train to effect this motion in view of the prior art (see U.S. Pat. No. 5,714,300 to Bales). Klieman and the prior art however, do not disclose a motion compensating member integrated in the rotational gear train so that a drive of the rotational gear train caused by a pivoting movement of the effector is compensated when the pivoting gear train is driven by the instrument handle to pivot the effector as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| | | |
|-------------------|----------|---------------------------------|
| US 5174300 A | USPAT | Bales; Thomas O. et al. |
| US 5275608 A | USPAT | Forman; Jeffrey L. et al. |
| US 5330502 A | USPAT | Hassler; William L. et al. |
| US 5350391 A | USPAT | Iacovelli; Benedetto |
| US 5374277 A | USPAT | Hassler; William L. |
| US 5472451 A | USPAT | Freitas; Michael W. et al. |
| US 5474571 A | USPAT | Lang; Dieter |
| US 5545148 A | USPAT | Wurster; Helmut |
| US 5549637 A | USPAT | Crainich; Lawrence |
| US 5582617 A | USPAT | Klieman; Charles H. et al. |
| US 5603723 A | USPAT | Aranyi; Ernie et al. |
| US 5607450 A | USPAT | Zvenyatsky; Boris et al. |
| US 5609601 A | USPAT | Kolesa; Michael S. et al. |
| US 5643294 A | USPAT | Tovey; H. Jonathan et al. |
| US 5702408 A | USPAT | Wales; Kenneth S. et al. |
| US 5743456 A | USPAT | Jones; Christopher Scott et al. |
| US 5827323 A | USPAT | Klieman; Charles H. et al. |
| US 5997565 A | USPAT | Inoue; Masahide |
| US 6068647 A | USPAT | Witt; David A. et al. |
| US 20020040217 A1 | US-PGPUB | Jinno; Makoto |
| US 20020055758 A1 | US-PGPUB | Sasaki; Katsumi |
| US 6666854 B1 | USPAT | Lange; Gregoire |
| US 6889116 B2 | USPAT | Jinno; Makoto |
| US 6936061 B2 | USPAT | Sasaki; Katsumi |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*
9/26/06

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER